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| 10/772,674      | 02/04/2004  | Marc Ira Lipton      | 8285/671            | 5600             |

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CHICAGO, IL 60610

EXAMINER

HOOSAIN, ALLAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2645

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/772,674

Applicant(s)

LIPTON ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## FINAL DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34-40,42-48,51-53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Hou et al.** (US 5,325,421).

As to Claims 34,46, with respect to Figures 3-5, **Hou** teaches a system for providing a session for ordering a telecommunication service, the system comprising:

a receiver, S1, associated with the telecommunication service to receive a reply message to a subscriber registration process (terms and conditions contract message) during a telecommunications call;

a SIU-21 processor in communication with the receiver;

a controller and database, 45 and 50, (database) in communication with the processor (Figure 1);

wherein the processor creates a record of the session in the database, wherein the database maintains a recorded audio representation of an account code (at least a portion of the telecommunication call) which documents that an individual has affirmatively accepted the terms and conditions contract (Col. 6, lines 2-15).

As to Claim 35, **Hou** teaches the system of claim 34 wherein the reply message includes a spoken message indicative of acceptance of the registration (terms and conditions contract) (Col. 5, lines 25-46).

As to Claims 36,47, **Hou** teaches the system of claim 34 wherein the record includes subscriber identification information (Col. 2, lines 54-65).

As to Claim 37, **Hou** teaches the system of claim 34 wherein the record includes service identification information (Col. 3, lines 24-42).

As to Claim 38, **Hou** teaches the system of claim 34 wherein the record includes an end of registration notification (a time) and at which the telecommunication service is ordered (Col. 6, lines 60-68).

As to Claim 39, **Hou** teaches the system of claim 34 wherein the record includes a calling party identification for the telecommunication call (Col. 13, lines 27-50).

As to Claims 40,48, **Hou** teaches the system of claim 34 wherein the recorded audio representation is of a substantially entire portion of the call to document that the individual has affirmatively accepted the terms and conditions contract (Col. 6, lines 8-10).

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As to Claims 42,51, **Hou** teaches the system of claim 34 wherein the terms and conditions contract message includes a verbal message (Col. 6, lines 63-65).

As to Claims 43,52, **Hou** teaches the system of claim 34 wherein the telecommunication service includes a telephone service (Col. 6, lines 65-68).

As to 44,53, **Hou** teaches the system of claim 34 wherein the telecommunications call includes a voice call (Col. 6, lines 65-68).

As to Claim 45, **Hou** teaches the system of claim 35 wherein the processor at least one of connects the individual to an operator and terminates the telecommunication call if the individual fails to affirmatively accept the terms and conditions contract (Col. 6, lines 63-65).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 41,49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hou** in view of **Shelton** (US 5,345,501).

As to Claims 41,49-50, **Hou** teaches the system of claim 34 further comprising:

**Hou** does not teach the following limitation:

“at least one of a printer and a facsimile machine to generate a written confirmation of the terms and conditions contract”

However, it is obvious that **Hou** suggests the limitation. This is because **Hou** teaches billing of subscribers accounts (Col. 6, lines 1-2). **Shelton** teaches mailing receipts to customers (Col. 5, lines 22-25). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add mailing of receipts to **Hou**'s invention for confirming orders as taught by **Shelton**'s invention in order to provide receipts for services provided.

6. Claims 34-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shelton** in view of **Shimada et al.** (US 6,169,787).

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As to Claims 34-53, with respect to Figures 1-5, **Shelton** teaches a system for providing a session for ordering a telecommunication service, the system comprising:

a receiver, 12, associated with the telecommunication service to receive a reply message to a customer order (terms and conditions contract message) during a telecommunications call;

a VRU processor in communication with the receiver (Figure 1, label 20);

an adjunct 22 (database) in communication with the processor (Figure 1);

wherein the processor creates a record of the session in the database, wherein the database maintains a recorded audio representation of an account code (at least a portion of the telecommunication call) which documents that an individual has affirmatively accepted the terms and conditions contract (Col. 6, lines 2-15);

**Shelton** does not teach the following limitation:

“a recorded audio representation of at least a portion of the telephone call”

However, it is obvious that **Shelton** suggests the limitation. This is because **Shelton** teaches that recorded prompts and responses could be by voice recognition (Col. 5, lines 5-9). **Shimada** teaches recording transactions during a telephone call (Col. 9, lines 43-58). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add recorded transactions to **Shelton's** invention for confirming transactions as taught by **Shimada's** invention in order to provide evidence of service offered.

***Response to Arguments***

7. Applicant's arguments filed in the 8/29/05 Remarks have been fully considered but they are not persuasive because of the following:

**Hou** teaches a caller subscribing to voice dialing telephone services. The subscription is a contract. During the call the caller registers calling labels which are conditions for the subscription. Also, the caller specifies how the caller should be billed for the calls. The billing process is the terms for the subscription (see Col. 2, lines 54-62, Col. 3, lines 24-42 and Col. 3, line 58 through Col. 4, line 12).

The disclosure is not clear on what is meant by 'terms', 'conditions' and 'contract'. Based on the ordinary meanings of the words, and as explained above, Examiner respectfully believes that **Hou** teaches a 'terms and conditions contract' as recited in the argued limitation. The fact that the caller becomes a subscriber and makes voice dialing calls is a confirmation that the caller affirmatively accepted the 'terms' and 'conditions' for the subscription (contract) (see Col. 6, lines 65-68).

Examiner respectfully believes that the combinations of **Hou** with **Shelton** and **Hou** with **Shimada** were proper for the reasons given above.

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.



***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Walker et al.** (US 6,345,090) teach conditional purchase offers to callers requesting telephone services.

**Ginzboorg et al.** (US 6,047,051) teach charging customers who ordered telephone services.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

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(571) 273-8300, (for formal communications; please mark "EXPEDITED PROCEDURE")

**Or:**

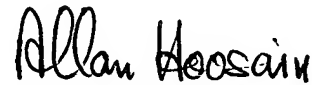
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Carlyle, Alexandria, VA 22313 (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

  
**Allan Hoosain**  
**Primary Examiner**  
**11/16/05**